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EXAMINER

SHAY, D

ART UNIT

PAPER NUMBER

3739

13

DATE MAILED: 01/30/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on October 23, 2000 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

1. ☐ Claims \_\_\_\_\_ are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☐ Claims \_\_\_\_\_ are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 3739

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-32, 34, 35, 39, 40, 44, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 28 there has been an apparent omission in the phrase "said irradiating step comprises irradiating the walls of an airway in the lung in <sup>a</sup> change in smooth muscle tissue..." For the purposes of examination this phrase will be read as -- said step of irradiating the walls of the airway of a lung causing a change in smooth muscle tissue... --. Claims 29, 30, 34, 35, 39, 40, 44 and 45 are indefinite because it is unclear how any steps recited therein manipulatively affect the method.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 37, 50, and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dierkesmann.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3739

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-32, 34-36, and 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dierkesmann in combination with Clarke et al. Dierkesmann teaches a method as claimed except the laser wavelength, discussion of spasm and discussion of the ureter and esophagus, per se. Clark<sup>e</sup> et al teach the use of wavelengths between 300 and 1000 nm, ~~dr~~ wherein 300 nm is considered "about 240 nm" to treat obstruction<sup>s</sup> in the lumens of smooth ~~dr~~ muscled organs. It would have been obvious to the artisan of ordinary skill to employ a radioactive source, since these<sup>are</sup> notorious equivalents to lasers in reducing smooth muscle tissue, ~~dr~~ official notice of which is hereby taken, to employ the method on the <sup>e</sup>sophagus, or urethra, ~~dr~~ since these are equivalents and both are recognized as composed of smooth muscled organs that respond to the same irradiative methods as blood vessels and bronchial tissue, official notice of which is hereby taken and to employ the method of Dierkesmann on an asthmatic lung. Since there is no indication that such lungs are immune to the tumors Dierkesmann seeks to treat, thus producing a method such as claimed.

Claims 1-27, 48 and 49 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

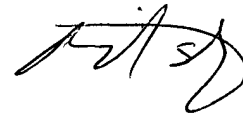
Art Unit: 3739

Applicant's election with traverse of Group II in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the examiner has not indicated how the device could be used for a substantially different method. This is not found persuasive because there is no requirement that the examiner develop such a method. However, the elongated body would be inserted into the lens rod the cataract<sup>c</sup> ablated. 2

The requirement is still deemed proper and is therefore made FINAL.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
January 12, 2001



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330